

REMARKS

Claims 44-54 are pending. Claims 44-54 are rejected.

Prosecution reopened

Applicant filed a notice of appeal on May 11, 2007 to appeal the Examiner's rejection of claims in the Final Office Action mailed on February 12, 2007. Subsequently, Applicant filed an Appeal Brief on July 10, 2007 and a supplemental Appeal Brief on February 29, 2008. Applicant received no Examiner Answer. Instead, Applicants received this Office Action. Subsequently, Applicant called the Examiner for clarification. The Examiner indicated that the Office Action was mailed after the USPTO reviewed Applicant's appeal briefs.

Accordingly, Applicant assumes the USPTO re-opened prosecution of the instant application in response to Applicant's appeal briefs.

Rejections under 35 U.S.C. §102

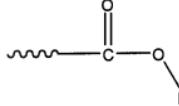
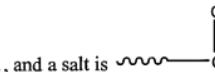
Claims 44-46 and 53-54 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,631,328 to Wang et al. ("Wang").

Claim 44 defines a method of coating an implantable medical device. The method comprising (1) adding a copolymer of an ethylene comonomer with a carboxylic acid comonomer to a solvent system to form a composition, (2) applying the composition to an implantable medical device, and (3) allowing the solvent system to evaporate.

Wang describes forming a composition of ionomers that can form a film (col. 6, lines 17-63). The composition can be formed of three monomers: (a) an alpha-olefin, (b) an ester of alpha, beta-ethylenically-unsaturated carboxylic acid (see col. 2, lines 55 and 56), and (c) a metal salt of acrylic or methacrylic acid (col. 2, lines 55-59; col. 4, line 59 through col. 5, line 63).

Therefore, Wang does not describe forming a coating including a copolymer of an ethylene comonomer with a carboxylic acid comonomer. Esters of a carboxylic acid and metal salts of a carboxylic acid are totally different chemical entities from the carboxylic acid.

A carboxylic acid is a compound is , an ester is

, and a salt is . In addition, esters of a carboxylic acid and metal salts of a carboxylic acid have totally different physical and mechanical properties than the carboxylic acid. For example, as an ordinary artisan would recognize, an ester of a carboxylic acid is more hydrophobic than the carboxylic acid. Conversely, a metal salt of the carboxylic acid is more hydrophilic than the carboxylic acid. A film formed of an ester of a carboxylic acid or a metal salt of a carboxylic acid would have totally different physical, mechanical, or drug release properties than a film formed of a carboxylic acid. A key aspect of the Wang reference is to use a combination of an ester and metal salt of a carboxylic acid monomers for forming a film which has low haze (col. 1, lines 13-19), which attests to the different film properties that different monomers in a polymer of the film can impart to the film.

In the Office Action, the Examiner states that he disagrees with Applicant since Applicant claims a carboxylic acid but not a specific entity. Applicant respectfully fails to see the relevance of this statement. As is clearly seen from the discussion above, an ester or salt is NOT a species of a carboxylic acid; these compounds are chemically and physically different and, when form a film, impart entirely different biological and mechanical properties to a film (see the discussion above).

In sum, Wang fails to disclose the copolymer as recited in claim 44. Claim 44 is therefore patentably allowable over Wang. Claims 45, 46, 53 and 54 depend from claim 44 and are patentably allowable over Wang for at least the same reason.

Rejections under 35 U.S.C. §103

Claims 47, 48, and 50-52 are rejected under 35 U.S.C. 103(a) as being obvious over Wang in view of U.S. Patent No. 6,087,412 to Chabrecek et al. ("Chabrecek").

Claims 47, 48 and 50-52 depend from claim 44, which is discussed above, and therefore require a copolymer of an ethylene comonomer with a carboxylic acid comonomer, which is entirely different from the copolymer described by Wang.

Chabrecek describes a macromer that include a segmented copolymer which is an amide (col. 1, line 20 through col. 2, line 23). Chabrecek does not describe a copolymer of an ethylene comonomer with a carboxylic acid comonomer. Therefore, Chabrecek does not cure the deficiencies of Wang, which is discussed above. Therefore, claims 47, 48 and 50-52 are patentably allowable over Wang in view of Chabrecek.

Claim 49 is rejected as being obvious over Wang in view of U.S. Patent No. 4,729,914 to Kliment et al. ("Kliment").

Claim 49 depends from claim 44, which is discussed above, and thus requires a copolymer of an ethylene comonomer with a carboxylic acid comonomer, which is entirely different from the copolymer described by Wang.

Kliment describes forming an N-vinylpyrrolidone copolymer that can include ethylenic monomers such as hydroxylethyl methacrylate or hydroxylpropyl acrylate. Hydroxylethyl methacrylate or hydroxylpropyl acrylate is an ester of methacrylate or acrylate, which is not a carboxylic acid (see the discussion of Wang, *supra*). Therefore, Kliment does not describe a copolymer of an ethylene comonomer with a carboxylic acid comonomer and thus does not cure the deficiency of Wang. Accordingly, claim 49 is patentably allowable over Wang in view of Kliment.

The undersigned authorizes the examiner to charge any fees that may be required or credit of any overpayment to be made to Deposit Account No. 07-1850.

CONCLUSIONS

Withdrawal of the rejection and allowance of the claims are respectfully requested.

If the Examiner has any suggestions or amendments to the claims to place the claims in condition for allowance, applicant would prefer a telephone call to the undersigned attorney for approval of an Examiner's amendment. If the Examiner has any questions or concerns, the Examiner is invited to telephone the undersigned attorney at (415) 393-9885.

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Respectfully submitted,

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